THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 36

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HANS REICHENECKER

Appeal No. 96-0114
Application No. 08/128,279[1]

HEARD: June 8, 1999

Before KIMLIN, PAK, and KRATZ, Administrative Patent Judges.

PAK, Administrative Patent Judge.

DECISION ON APPEAL

[1] Application for patent filed September 29, 1993. According to appellants, the application is a continuation of Application No. 07/615,170, filed November 19, 1990.

This is a decision on an appeal from the examiner's final rejection of claims 12 and 15 through 17. Claims 1 through 11 stand withdrawn from consideration by the examiner as being directed to a nonelected invention under 37 CFR § 1.142(b).

Claim 12 is representative of the subject matter on appeal and reads as follows:

12. Starch cushioning particles formed by: feeding starch granules into a drum; adding a nucleating agent having a particle size of approximately 40μ in a quantity of from 0.1 to 0.2% of the weight of the starch granules; drum-coating the starch granules with the nucleating agent in the drum such that the nucleating agent is finely distributed onto the surfaces of the starch granules; feeding the drum-coated starch granules to an extruder and converting the drum-coated starch granules into a viscous-liquid state; applying heat to the extruder to generate in the viscous-liquid starch bubble nuclei from the decomposition of the nucleating agent; gassing the viscous-liquid starch with a propellant gas such that the starch and nucleating agent mixture is supersaturated with the propellant gas to generate a composition of molten starch foam by expanding the bubble nuclei; cutting the starch foam upon leaving the extruder; and providing for expansion of the starch foam to form the starch particles.

The examiner has relied upon the following reference in support of his rejection:

Osipow et al. (Osipow) 4,328,319 May 4, 1982

Claims 12 and 15 through 17 stand rejected under 35 U.S.C.

§ 112, first paragraph, as the specification fails to provide an enabling disclosure for the claimed invention.[2]

We reverse.

According to ***In re Vaeck***, 947 F.2d 488, 496 n.23, 20 USPQ2d 1438, 1444-1445, n.23 (Fed. Cir. 1991):

> The first paragraph of 112 requires nothing more than objective enablement. ***In re Marzocchi***, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971). How such a teaching is set forth, either by the use of illustrative examples or by broad terminology, is irrelevant. ***Id.***

Where, as here, appellant's specification contains a description of the manner of making and using the invention corresponding in scope with those of the claims, compliance with the enablement requirement of the first paragraph of Section 112 is presumed. ***Marzocchi***, 439 F.2d at 223-224, 169 USPQ at 369-370. It is the examiner's burden to present adequate evidence for doubting the objective truth of

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[2] In the Answer, the examiner inadvertently did not repeat the rejection of claims 12 and 15 through 17 under 35 U.S.C. § 112, first paragraph. However, as is apparent from page 2 of the final Office action and appellant's Brief, claims 12 and 15 through 17 stand rejected under 35 U.S.C. § 112, first paragraph, "for the reasons set forth in the objection to the specification."

appellant's statements in the specification. ***Id.*** Mere conclusory remarks by the examiner regarding a propellant gas are not sufficient to satisfy his or her burden. Note that there is nothing inconsistent about feeding a propellant gas ("a liquefied gas with a vapor pressure greater than atmospheric pressure at 105 deg. F") under adequate pressure to permit its introduction into an extruder containing a viscous liquid starch composition and causing the conversion of a propellant gas (liquid form) to a gaseous form in an extruder due to temperature and pressure conditions therein. See Brief, page 7. The very reference the examiner relied upon to justify his
§ 112 rejection also supports appellant's conclusion that one of ordinary skill in the art would know how to select "suitable propellants" for making cushioning particles without undue experimentation. The examiner's doubt as to why the specification is inadequate is simply unsupported by any evidence. ***Marzocchi***, 439 F.2d at 224, 169 USPQ at 370. Accordingly, we reverse the examiner's decision rejecting

claims 12 and 15 through 17 under 35 U.S.C. § 112, first paragraph.

As a final point, we note appellant's statement regarding the criticality of distributing a nucleating agent **uniformly** and finely "onto the surfaces of the starch granules". See Brief, page 6, together with specification, page 9.

Upon return of this application, the examiner should determine whether failure to recite a critical feature, i.e., **uniform** distribution of a nucleating agent, in the appealed claims violates the enablement requirement of the first paragraph of Section 112. ***See In Mayhew***, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

No time period any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED

EDWARD C. KIMLIN Administrative Patent Judge	)
CHUNG K. PAK Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
PETER F. KRATZ Administrative Patent Judge	)

CKP:lp

FELIX J. D'AMBROSIO
P.O. BOX 2266 EADS STATION
ARLINGTON, VA 22202

Leticia

Appeal No. 96-0114
Application No. 08/128,279

APJ PAK

APJ KIMLIN

APJ KRATZ

DECISION: REVERSED
Send Reference(s): Yes No
or Translation (s)
Panel Change: Yes No
Index Sheet-2901 Rejection(s): _____

Prepared: January 31, 2000

Draft Final

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OB/HD GAU

PALM / ACTS 2 / BOOK
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